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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,178

02/28/2005

Raman Kumar Bakshi

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210 7590 12/27/2007  
MERCK AND CO., INC  
P O BOX 2000  
RAHWAY, NJ 07065-0907

EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

12/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/526,178	<b>Applicant(s)</b> BAKSHI ET AL.	
	<b>Examiner</b> /Venkataraman Balasubramanian/	<b>Art Unit</b> 1624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 5-25, 29-32 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-25, 29-32 and 37-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicants' response, which included cancellation of claims 2-4, 26-27, 40 and amendment to claims 1 and 18, filed on 10/12/2007, is made of record. Claims 1, 5-25, 29-32 and 37-39 are now pending. In view of applicants' response the 112 first paragraph rejection, 102 rejections and 103 rejection over Gante et al., have been rendered moot and or obviated. however, the following 103 rejections are maintained.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

Art Unit: 1624

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 5-25, 29-30, 32 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolf et al., US 6,344,449.

Rudolf et al., teaches several piperazine compounds useful as neurotransmitter, which include instant compounds, composition and method of use. See column 1, formula I and note with given the definition of all variable groups, the compounds taught by Rudolf et al., include instant compounds. See column 2-32 for details of the preferred embodiments and process of making these compounds. Particularly, see column 32-64 for various species made. Note various piperidinecarbonyl and piperazinecarbonyl compounds are taught therein. See entire document. Especially see examples 269 and 275. See CAPLUS Abstract.

Instant claim 28 differs from Rudolf et al., in requiring various choices of  $R^1$ ,  $R^2$  and other variable groups. Although Rudolf et al. include all such choices in the variable group definition of formula shown in column 1, Rudolf et al., does not exemplify all the compounds of subgenus piperazinyl carbonyl. However, Rudolf et al., teaches large number of such variation with piperidinyl carbonyl compounds. In addition Rudolf et al., teaches equivalency of the compounds taught in column 32-64 with those generically claimed in column 1.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make various compounds of formula I using

teachings of Rudolf et al., and expect resulting compounds to possess the uses taught by the art in view of the equivalency teaching outline above.

This rejection is same as made in the previous office action but now excludes cancelled claims and claim 31. Applicants' traversal to overcome this rejection is not persuasive. Contrary to applicants urging Rudolf et al., permits substituted benzyl group as evident from the examples cited above. The substituents exemplified include bromo, amino, hydroxy etc., and one trained in the art would be motivated make various benzyl substituted compounds analogous to the exemplified compounds as Rudolf provides guidance as to how to make them. See R<sup>2</sup> definition especially those shown in column 24, which includes instant substituents. See also column 161-174 for various R<sup>2</sup> bearing compounds. Thus, Rudolf et al., provides adequate guidance to make various R<sup>2</sup> choices including substituted benzyl.

As for applicants' argument, the use taught by Rudolf et al., is different from instant use, it does not matter. One trained in the art would be motivated make the compounds taught by Rudolf et al., for the use taught therein.

Hence, this rejection is proper and is maintained.

Claims 1, 5-25, 29-32 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morriello et al., US 5,721,250.

Morriello et al., teaches several piperidine compounds useful for treating obesity which include instant compounds, composition and method of use. See column 2, formula I and note the definition of all variable groups. With these definition, the compounds taught by Morriello et al., include instant compounds. See column 2-24 for

Art Unit: 1624

details of the preferred embodiments. Particularly, see column 18 for various urea species. See column 27-31 for process of making these compounds. See column 47-150 for various compounds made. . Especially see column 148, entry 8 and 9.

Instant claim 28 differs from Morriello et al., in requiring various choices of  $R^1$ ,  $R^2$  and other variable groups. Although Morriello et al., include all such choices in the variable group definition of formula shown in column 2, Morriello et al., does not exemplify all the compounds of subgenus piperaziny carbonyl. However, Morriello et al., teaches large number of such variation with hetero carbonyl compounds. In addition Rudolf et al., teaches equivalency of the compounds taught in column 47-150 with those generically claimed in column 1.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make various compounds of formula I using teachings of Morriello et al., and expect resulting compounds to possess the uses taught by the art in view of the equivalency teaching outline above.

This rejection is same as made in the previous office action but now excludes cancelled claims. Applicants' traversal to overcome this rejection is not persuasive. Contrary to applicants urging Morriello et al., permits substituted benzyl group as evident from  $R_1$  definition which permits substituted arylalkyl. The substituents recited therein include instant substituents on the benzyl and one trained in the art would be motivated make various benzyl substituted compounds analogous to the exemplified compounds as Morriello provides guidance as to how to make them. See also column 8 line 35-40 wherein benzyl and benzyl with fluoro substituents is recited as preferred

choices. Thus, Morriello et al., provides adequate guidance to make various R<sub>1</sub> choices including substituted benzyl.

As for applicants' argument, the mode of action taught by Morriello et al., is different from instant. it does not matter. One trained in the art would be motivated make the compounds taught by Morriello et al., for the use taught therein, namely for treating obesity.

Hence, this rejection is proper and is maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is

Art Unit: 1624

James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Venkataraman Balasubramanian/

Primary Examiner, Art Unit 1624

12/25/2007